

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: James A. Parker	Art Unit:	: 2144
Serial No.	: 09/915,719	Examiner:	: Maniwang, Joseph R.
Filing Date	: July 25, 2001		
Title	: Electronic Mail File Access System		

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

INFORMATION DISCLOSURE STATEMENT

Dear Sir:

Assignee cites the Federal Circuit's decision called *In re Nuijten*, No. 06-1371 (Fed. Cir. Sept. 20, 2007) (available at <http://www.fedcir.gov/opinions/06-1371.pdf>).

No PTO-1449 is considered needed. The sole item of information contained in this information disclosure statement was not known to any person mentioned in Rule 56 more than three months before the filing of this information disclosure statement.

In the *Nuijten* case, the Court observed that the PTO had allowed certain claims types already: "Nuijten has been allowed claims to the process he invented, a device that performs that process, and a storage medium holding the resulting signals." Slip op. at 6. The Court continued: "The claims whose disallowance Nuijten appeals are not traditional step-by-step process claims, nor are they directed to any apparatus for generating, receiving, processing, or storing the signals. As mentioned above, such claims have been allowed. The claims on appeal seek to cover the resulting encoded signals themselves." *Id.*

The Court affirmed a PTO rejection of claim 14 of Nuijten's application, the "pure signal" claim, which was directed to "[a] signal with embedded supplemental data, the signal being encoded in accordance with" *Id.*

The Court's holding was, "The claims on appeal cover transitory electrical and electromagnetic signals propagating through some medium, such as wires, air, or a vacuum. Those types of signals are not encompassed by any of the four enumerated

statutory categories: ‘process, machine, manufacture, or composition of matter.’” Slip op. at 8.

Key to the Court’s decision was the foundational construction of the signal claim, namely, “while the claims are limited so as to require some physical carrier of information, they do not in any way specify what carrier element is to be used. The only limitations in Claim 14 address the signal’s informational content.” Slip op. at 10.

Based on definitions found in earlier cases, the Court held that a signal did not fall into the statutory class of “machine” because it did not have “concrete structure.” Slip op. at 13-14.

Based on definitions of “manufacture” and “article,” the Court held that inventions within the statutory class of “manufactures” must be “tangible,” a definition that excludes “[a] transient electric or electromagnetic transmission.” Slip op. at 16.

Assignee wishes to add a few words regarding the relevance of *In re Nuijten* to claim 53 pending in this application. As amended, claim 53 reads, in pertinent part:

53. “An apparatus comprising: (1) an Internet computer along a transmission path between a source computer and a destination computer on the Internet computer network; and (2) a data stream in transit through the Internet computer, the data stream encoding data arranged in a plurality of data frames and comprising”

The recited “computer” in part (1) meets the restrictions of “tangible” and “concrete structure,” which distinguishes the *Nuijten* Court’s analysis. The fact that a “data stream in transit” is *added* in combination with a tangible, concrete structure does not lessen that distinction.

In the *Nuijten* case, there was no doubt that claims directed to “a storage medium holding the resulting signals” was allowable. In claim 53 here, likewise, the recited “computer” is stated to hold the “data stream” that is “in transit” through it and is equally patentable.

In *Nuijten*, the Court relied on the fact that the “signal” claim did not specify what medium contained the signal. In claim 53, by contrast, it is clearly specified that

the signal is passing through a computer, so a medium is specified, further distinguishing the case.

As previously explained, assignee presenting claim 53 in the format in which it is written to avoid any issues arising from Section 101 and the unsettled state of the law related to signal claims under that statute.

The *Nuijten* decision contained a lengthy and serious dissent, and it is possible that the case will be subject to further proceedings, such as an *en banc* petition or a request for *certiorari* to the Supreme Court. Regardless of the final outcome, though, it seems clear that the rules under Section 101, even if *In re Nuijten* remains the law as stated in the cited decision, allow for patentability of claim 53 here, because that claim steers well clear of any controversial extension of patentable subject matter.

Assignee respectfully requests that the Examiner review the case decision and take it into account, along with the above comments, during reconsideration of the application as amended. If there are any questions, or if it would help to discuss these issues orally, assignee's undersigned attorney is available upon request.

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by its attorney

Dated: September 28, 2007

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